

containing subject matter not enabled and described in the specification, and 35 U.S.C. §112, second paragraph, for being indefinite.

Specifically, the outstanding Office Action asserts that Claims 5-16 were rejected: under 35 U.S.C. §101 because “[i]t is not possible for the blade to move in negative speeds, [i]t is unclear whether the blade travel direction for cutting the optical fiber occurs during negative blade speed, and [i]t is not possible for the blade to have negative blade thickness to derive positive speeds;” under 35 U.S.C. §112, first paragraph, “because the specification, while being enabling for moving a cutting blade greater than 0 mm/minute, does not reasonably provide enablement for moving the blade at a speed less than 0 mm/minutes,” and “[t]he specification, as originally filed, fails to provide support for “ $\beta \leq -253\alpha + 65$ , and when the speed of  $\beta$  is positive, the cutting blade moves in a direction for cutting optical fiber;” and under 35 U.S.C. §112, second paragraphs, because “it is unclear how a blade can travel in negative speed and have a thickness to meet the expression.”

First, as stated in previous responses, the tests for the written description and enablement issues under 35 U.S.C. §112, first paragraph, are whether the application as originally filed provides “adequate support” for the claims in Applicant’s disclosure in light of Applicants’ disclosure including the specific embodiments and figures,<sup>1</sup> and whether one

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<sup>1</sup> MPEP 2163 states that “[t]he issue raised in the cases is most often phrased as whether the original application provides “adequate support” for the claims at issue ...,” and that “[p]rior to determining whether the disclosure satisfies the written description requirement for the claimed subject matter, the examiner should *review the claims and the entire specification, including the specific embodiments, figures, and sequence listings, to understand how applicant provides support for the various features of the claimed invention*” (emphasis added in Italic).

skilled in the art, given the level of knowledge and skill, will be able to practice the claimed invention without undue experimentation.<sup>2</sup>

As stated in our previous responses to Office Actions, for cutting the optical fiber by moving the cutting blade, the cutting speed of the cutting blade should be more than zero as a matter of course since a negative speed would be nonsensical as stated in the Office Action itself. Furthermore, since Applicants' disclosure includes Figures 1 and 2 showing an exemplary device as an embodiment according to the present invention, it is evident as to which directions the blade moves, i.e., either the direction of cutting the optical fiber held in the device or the direction opposite thereto. Also, it would be quite self-evident that the thickness of the blade has to be a positive value in the equation, because to have a negative value for the thickness of the blade would be nonsensical. Thus, it is respectfully submitted that referring to Applicants' disclosure and given the mathematical expression,  $\beta \leq -253\alpha + 65$  (mm/minute), recited in Claims 5 and 11, one ordinarily skilled in the art would be able to *reasonably* recognize and practice *without undue experimentation* that the speed or velocity of the cutting blade would be more than zero.

Further, in rejecting Claims 5-16 under 35 U.S.C. §112, first paragraph, the Office Action clearly agrees that "*the specification, while enabling for moving a cutting blade greater than 0 mm/minute, does not enable reasonably provide enablement for moving the blade at a speed less than 0 mm/minute* (emphasis added in Italic)" and states that "[s]peed is an absolute value." Also, in rejecting Claims 5-10 under 35 U.S.C. §112, second paragraph,

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<sup>2</sup> MPEP 2164.08, stating that "[a]ll that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art," that "[f]urther the scope of enablement must only bear a 'reasonable correlation' to the scope of the claims," and that "[t]he second inquiry is to determine if one skilled in the art is enabled to make and use the entire scope of the claimed invention without undue experimentation."

the Office Action further states that “speed is always a positive number (absolute value).” Furthermore, although the Office Action asserts that “Examiner’s physics book does not use the term “speed” synonymously with the term “velocity,” one ordinarily skilled in the art, having a certain level of knowledge and skill in the art, would not be confined to such a strict interpretation but would be able to recognize that speed quite frequently means velocity as described in major standard dictionaries. Thus, from the reading of the specification, it would be quite evident to one ordinarily skilled in the art that “speed” can also means velocity, and any negative values for  $\beta$  would not be workable and  $\alpha$  is necessarily a value which always gives rise to  $\beta$  of more than 0 mm/minute. Therefore, Claims 5-16, of which Claim 5 recites “when the speed  $\beta$  is positive, the cutting blade moves in a direction for cutting the optical fiber,” and Claim 11 recites “when the velocity  $\beta$  is positive, the cutting blade moves in a direction for cutting the optical fiber,” are believed to be in full compliance with the requirements of the outstanding rejections under 35 U.S.C. § 112, first and second paragraphs.

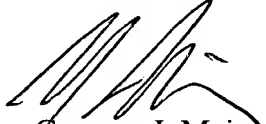
Claims 5-16 all directed to methods for cutting an optical fibers and being fully compliance with the requirements of 35 U.S.C. § 112, first paragraph, for the reasons discussed above, Claims 5-16 are believe to be in compliance with the utility requirement under 35 U.S.C. § 101.

Finally, Applicants wish to point out that the Office Action states that the claims lack some features. However, these features merely avoid occurrences of impossible situations such as a moving speed or a thickness of a cutting blade being less than zero, as the Examiner himself recognizes. Therefore, it is believed that it would be unnecessary to add these features to the claims since they do not have substantial meaning. In other words, it is believed that one skilled in the art would be able to carry out the claimed subject matter even if these features are not present in the claims.

In view of the declaration submitted herewith and the discussions presented above, it is respectfully submitted that the present application is in condition for allowance, and an early action favorable to that effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Gregory J. Maier  
Registration No. 25,599  
Robert T. Pous  
Registration No. 29,099  
Attorneys of Record



**22850**

Tel: (703) 413-3000

Fax: (703) 413-2220

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